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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte NARUTOSHI FUKUZAWA

Appeal 2009-005170
Application 10/657,244
Technology Center 2600

Oral Hearing Held: October 8, 2009

Before KENNETH W. HAIRSTON, MARC S. HOFF, and
THOMAS S. HAHN, *Administrative Patent Judges*.

ON BEHALF OF THE APPELLANT:

HARRIS A. PITLICK, ESQUIRE
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32 The above-entitled matter came on for hearing Thursday, October 8,
33 2009, commencing at 9:00 a.m., at the U.S. Patent and Trademark Office,
34 600 Dulany Street, Alexandria, Virginia, before Victor Lindsay, Notary
35 Public.

1 THE USHER: Calendar No. 25, Mr. Pitlick.

2 JUDGE HAIRSTON: Good morning, counselor.

3 MR. PITLICK: Good morning.

4 JUDGE HAIRSTON: Do you mind spelling your name for the
5 record?

6 MR. PITLICK: P -- I have a business card.

7 JUDGE HAIRSTON: That's even better. We have -- before you
8 begin, we have visitors from the European Patent Office, they're going to
9 observe today.

10 MR. PITLICK: Okay.

11 JUDGE HAIRSTON: So you have to do a great job.

12 MR. PITLICK: Well, I'm waiting for the court reporter to tell me I
13 can start.

14 COURT REPORTER: Whenever you are ready, sir.

15 MR. PITLICK: Okay. What we have here in terms of the claimed
16 invention, we have an optical recording medium and a method of recording,
17 reproducing in effect, using the optical recording medium. The invention
18 here concerns the recording layer and particularly the organic compound
19 which is present in the recording layer. It's a -- at least 1,1 monomethine
20 cyanine dye, and it's got three significant characteristics. Number one, it has
21 to have a minimum value of the refractive index, which we refer to as N-
22 MIN, and it has to be within a particular range. The organic compound has
23 to have a refractive index of 1.2 or lower at a particular recording producing
24 wave length range, and it has to have a particular chemical structure.
25 Basically, we've got a Markush group of three types of structures, and these
26 have to do with a nitrogen-containing heterocyclic rings on either end of

1 these dyes which is a combination of indolenine and indolenine,
2 combination of benzothiazole and benzothiazole, or a combination of
3 benzothiazole and quinoline.

4 So the heart of this case is really whether this particular organic
5 compound is disclosed or otherwise suggested by the Kasaba reference --
6 Kasada, excuse me, Kasada et al. And as we pointed out in the various
7 briefs, Kasada et al. is substantially broader than the claims that are on
8 appeal. And we've argued that a case like *In re Beard* would apply here
9 because, as we've said in our Appeal Brief, in order to get from Kasada et al.
10 to what we have in our actually fairly narrow claim is like finding a needle
11 in a haystack. Not only do you have to pick and choose from the various
12 formulae of Kasada et al., and we have explained in our briefs that you have
13 to go to one particular formula to get the indolenine, another formula to get
14 the benzothiazole, you have to pick a certain Z. And you look at, for
15 example, column 3 beginning around line 38 of Kasada et al., you have
16 quite, quite a nice choices of Zs, and as a matter of fact, J doesn't even have
17 to exist. And once you do that, then you have to make sure that you meet
18 the other two limitations in terms of the refractive index.

19 So I mean I think it's fairly straightforward here and, again, it's --
20 well, as you say, it's a question of chemistry, but at any rate, we've got a
21 substantially narrow invention here. We've got a fairly broad disclosure
22 that's being relied on by the Examiner, and we feel under Section 103 and
23 cases like *In re Beard*, there's no *prima facie* case of obviousness.

24 JUDGE HOFF: Counsel, your Brief relatively casually mentions *In*
25 *re Beard*, I wonder if you could explain to me your reasons for feeling that
26 *In re Beard* is on point here?

1 MR. PITLICK: In *In re Beard*, I don't know -- I don't remember all
2 the facts, but the analogy there was the reference at -- and, again, it may
3 have been thousands, I don't remember exactly how many possible species -
4 -

5 JUDGE HOFF: Something like 100 million.

6 MR. PITLICK: Whatever, it was, it was a high number. And whether
7 we have 100 million here I don't think is that relevant because I don't think
8 *Beard* turned on whether there was a particular high number. The fact is the
9 number was substantially larger -- it was substantially large and there had to
10 be a fairly large amount of picking and choosing to get from here to there. I
11 might add also that the examples in Kasada et al. are important. I think
12 there's something like 40, 50, or so different compounds that are mentioned.
13 I don't remember the exact number, but I think we pointed this out in our
14 briefs, and none of them have the particular combination of groups that we
15 have. And, of course, Kasada et al. doesn't even disclose the other two
16 important characteristics, so in a way it's even -- we have an even stronger
17 case than *Beard* because *Beard* was simply a question of whether some
18 compounds were -- or an invention involving certain compounds were
19 obvious over a much larger genus of compounds. We have two other
20 limitations here that aren't even discussed in Kasada et al. So I hope I've
21 answered your question. Anyway --

22 JUDGE HOFF: So the Examiner's position with regard to -- we'll
23 move on to the other limitations -- the Examiner's position is that the
24 properties in the claim are inherent from the presence of the compound and
25 you disagree?

1 MR. PITLICK: Well, I mean certainly if you pick our compounds,
2 specifically say the dependent claims that we've argued severally, you're
3 going to get those refractive indices, but, again, these are three separate
4 limitations. You can pick a compound, for example, that has two indolenine
5 groups and not satisfy the, the other two limitations, so there's no basis for
6 the Examiner to say it's inherent. It's inherent certainly if you pick our
7 specific compounds from the reference. What we're saying is you would
8 never get to our specific compounds because, again, it's like a needle in a
9 haystack. And, and certainly if you look at the examples of Kasada, they're,
10 they're sending you somewhere else rather than our particular compounds.

11 JUDGE HAIRSTON: Is that it?

12 MR. PITLICK: That's it.

13 JUDGE HAIRSTON: Any other questions?

14 JUDGE HOFF: No, thank you.

15 JUDGE HAHN: No.

16 JUDGE HAIRSTON: Thank you, counselor.

17 MR. PITLICK: You're welcome.

18 (Whereupon, the proceedings were concluded.)